

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10003227-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert E. Haines

RECEIVED
CENTRAL FAX CENTER

Confirmation No.: 3806

Application No.: 09/738,795

Examiner: Thierry L. Pham

Filing Date: 12/13/2000

Group Art Unit: 2624

Title: A Consumable Management Device, an Image Forming System, and A Method of
Replenishing an Imaging Consumable

Mail Stop
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

Second
transmission

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- () Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
() No additional fee
(X) Other: Corrected Appeal Brief (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	1ST MONTH \$120.00	2ND MONTH \$450.00	3RD MONTH \$1020.00	4TH MONTH \$1690.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted
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number (571) 273-8300 on 09/25/2006
Number of pages: 27

Typed Name: Natalie King

Signature:

Robert E. Haines

By

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date:

9/25/06

Telephone No.: (509) 624-4276

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SEP 25 2006

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TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

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James D. Shaurette

Attorney/Agent for Applicant(s)

Reg. No. 39,833

Date: 9/25/06

Telephone No.: (509) 624-4276

Rev 12/04 (TrAmnPax)

SEP 25 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/738,795
Filing Date.....December 13, 2000
Inventor.....Robert E. Haines
Assignee.....Hewlett-Packard Development Company, L.P.
Group Art Unit 2624
Examiner..... T. Pham
Attorney's Docket No. PDNO. 10003227-1
Confirmation No..... 3806
Title: Consumable Management Device, An Image Forming System, And A
Method Of Replenishing An Imaging Consumable

BRIEF OF APPELLANT

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
Wells, St. John, P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3817

Appellant appeals from the Office Action mailed March 8, 2006 (hereinafter "Office Action" or "Action"). The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 08-2025.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

-i-

+ TABLE OF CONTENTS

I. <u>REAL PROPERTY IN INTEREST</u>	1
II. <u>RELATED APPEALS AND INTERFERENCES</u>	1
III. <u>STATUS OF CLAIMS</u>	1
IV. <u>STATUS OF AMENDMENTS</u>	1
V. <u>SUMMARY OF CLAIMED SUBJECT MATTER</u>	1
VI. <u>GROUND OF REJECTION TO BE REVIEWED ON APPEAL</u>	3
VII. <u>ARGUMENT</u>	3
A. Positively recited limitations of claims 1, 3-4, 7-9, 11, 13-14, 16-17, and 19-32 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	3
B. Positively recited limitations of claims 2, 10 and 15 are not disclosed nor suggested by the prior art references Hayward and Hogge and the obviousness rejection is improper for at least this reason.....	5
C. Positively recited limitations of claims 3 and 16 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	7
D. Positively recited limitations of claims 4, 11, and 17 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	8
E. There is insufficient motivation to combine the teachings of Hogge with the teachings of Hayward and the obviousness rejection of claims 5, 12 and 18 is improper for at least this reason.....	8

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

-ii-

F.	Positively recited limitations of claims 8 and 20 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	11
G.	Positively recited limitations of claims 21, 23 and 25 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	12
H.	Positively recited limitations of claims 22, 24 and 26 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	12
I.	Positively recited limitations of claims 27, 29 and 31 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.....	13
J.	Conclusion.....	14
VIII.	<u>CLAIMS APPENDIX</u>	A-1
IX.	<u>EVIDENCE APPENDIX</u>	B-1
X.	<u>RELATED PROCEEDINGS APPENDIX</u>	C-1

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

I. REAL PARTY IN INTEREST

The real party in interest of this application is Hewlett-Packard Development Company, L.P. as evidenced by the full assignment of the pending application to Hewlett-Packard Company recorded starting at Reel 011701, Frame 0111, and the full assignment to Hewlett-Packard Development Company, L.P. recorded starting at Reel 014061, Frame 0492, in the Assignment Branch of the Patent and Trademark Office. The Hewlett-Packard Development Company, L.P., is a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative, and the assignee of the pending application are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-32 are pending. Claims 1-32 stand rejected. Appellant appeals the rejections of claims 1-32.

IV. STATUS OF AMENDMENTS

No amendments have been filed after the Office Action mailed March 8, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of the subject matter defined in each of the independent claims and argued dependent claims involved in the appeal follow with respect to exemplary illustrative embodiments of the specification and figures.

Referring to independent claim 1, one example of a consumable management device is illustrated with respect to Fig. 4 and described in the associated

PDNO. 10003227-1
Serial No. 09/738,796
Brief of Appellant

specification teachings of page 8, lines 20+ of the originally filed application. Processing circuitry 44 and interface 50 are shown in the depicted example.

Referring to dependent claims 2, 10, and 15, generation of a second message in the form of a list including second designations is described in one embodiment at page 13, lines 3+ of the specification of the originally-filed application.

Referring to dependent claims 3 and 16, generation of a second message including quantity information is described at page 14, lines 14+ of the originally-filed specification in one embodiment.

Referring to dependent claims 4, 11 and 17, email communications and inclusion of a second designation as an attachment of the email is described at page 14, lines 26+ of the specification in one embodiment.

Referring to dependent claims 5, 12 and 18, one embodiment utilizing manufacturer part numbers and customer part numbers is described at page 11, lines 25+ of the specification.

Referring to dependent claims 8 and 20, one embodiment disclosing communication of second messages at a predetermined moment in time is described at page 13, lines 26+ of the specification.

Referring to independent claim 9, an example of an image forming device is described with respect to Figs. 1-3 of the originally-filed application and one example of a consumable management device is illustrated with respect to Fig. 4 and described in the associated specification teachings of page 8, lines 20+ of the originally filed application.

Referring to independent claim 14, a flow chart of Fig. 5 depicts an example of the claimed method including the claimed receiving, converting, generating and communicating according to one embodiment

Referring to dependent claims 21, 23 and 25, one example describing the claimed entities is set forth at page 9, lines 24+ of the originally-filed specification.

Referring to dependent claims 22, 24 and 26, utilization of plural designations for different entities is described at page 11, lines 25+ of the originally-filed specification.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

Referring to dependent claims 27, 29 and 31, one example of the forwarding second messages responsive to a predetermined status of an imaging consumable is described at page 14, lines 3+ of the originally filed application.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The 102 rejection of claims 1, 3-4, 7-9, 11, 13-14, 16-17, and 19-32 over Hayward.
- B. The 103 rejection of claims 2, 10 and 15 over Hayward and Hogge.
- C. The 102 rejection of claims 3 and 16 over Hayward.
- D. The 102 rejection of claims 4, 11, and 17 over Hayward.
- E. The 103 rejection of claims 5, 12 and 18 over Hayward and Hogge.
- F. The 102 rejection of claims 8 and 20 over Hayward.
- G. The 102 rejection of claims 21, 23 and 25 over Hayward.
- H. The 102 rejection of claims 22, 24 and 26 over Hayward.
- I. The 102 rejection of claims 27, 29 and 31 over Hayward.

VII. ARGUMENT

A. Positively recited limitations of claims 1, 3-4, 7-9, 11, 13-14, 16-17, and 19-32 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As set forth below, Appellant respectfully submits that positively-recited limitations of the claims are not disclosed by the prior art and the 102 rejection is improper for at least this reason.

The claims recite in varying forms a first message including a first designation identifying an imaging consumable, converting the first designation to a second designation identifying the consumable and a second message including the second designation. The Office relies upon the teachings of U.S. Patent No. 6,798,997 to Hayward (hereinafter "Hayward") as allegedly disclosing the first designation and conversion of the first designation to the second designation. Appellant respectfully disagrees and submits these claim limitations are not disclosed by the prior art.

The Office at page 2 of the Action identifies teachings in col. 5, lines 5+ of Hayward as disclosing the claimed first designation. In particular, the Office alleges that the teachings of Hayward of conditions indicating a need to replace consumable parts disclose the claimed first designation. As set forth in col. 5, lines 64 of Hayward, the condition sub-window of Fig. 4 identifies the consumable (e.g., magenta) associated with the condition. At page 3 of the Action, the Office relies upon the teachings of col. 7, lines 54- col. 8, lines 64 of Hayward as allegedly disclosing the claimed converting of the first designation identifying the imaging consumable to the second designation identifying the imaging consumable. Appellant respectfully submits the teachings of cols. 7 and 8 of Hayward fail to disclose or suggest the claimed converting and the rejection of the claims is improper for at least this reason.

Per col. 7, lines 54+ of Hayward, when the user clicks the "Buy Now" button of Fig. 4, the application program has already sensed the peripheral condition (e.g., "Magenta Ink Level Low" of Fig. 4) at step S32 of Fig. 7. Thereafter, the process S3 proceeds in Fig. 7 to launch the browser, display a purchase order, complete personal data and send purchase order. Per col. 8, lines 7+ of Hayward, the application launches an email to send the purchase order data to the

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

manufacturer's server. Appellant has failed to identify any teachings in Hayward of conversion from a first designation which identifies the consumable to a second designation which also identifies the consumable. The consumable is identified in the condition sub-window of Fig. 4 and per Fig. 7 of Hayward, a user may click the "Buy Now" button of Fig. 4 to place a purchase order of the consumable identified by the condition. There is no evidence of record in Hayward that the designation of the consumable is converted. Referring to col. 7, lines 64+ of Hayward, when the "Buy Now" button is selected by a user, the method S3 *fills out the purchase order screen at server 40 with the part number to be ordered based on the peripheral indicia and condition which was sensed at steps S31 and S32.* There is no evidence of any conversion of the part number or conversion of any other designation identifying the consumable from the sensing to the placing of the purchase order.

The Office identifies the purchase order of Hayward as disclosing the claimed second message. However, there is no evidence of record that the purchase order of Hayward includes a designation which was converted from another designation. The process of Hayward of communicating the condition regarding a consumable to a user and then the user placing a purchase order for the consumable using a part number for the consumable which was sensed as having a condition fails to disclose the claimed conversion of the designation identifying the consumable. There is no evidence of record of converting the part number used at col. 7, lines 63+ of Hayward for the consumable which has a condition and for which the purchase order is made.

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

B. Positively recited limitations of claims 2, 10 and 15 are not disclosed nor suggested by the prior art references Hayward and Hogge and the obviousness rejection is improper for at least this reason.

The claims recite in varying forms generation of a list including a plurality of second designations identifying a plurality of respective imaging consumables. Hayward teaches filling out a purchase order using a part number to be ordered per

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

col. 7, lines 63+. The Office on page 9 in support of the rejection states that is it well known that a plurality of different parts can be ordered using a single purchase order. Appellant traverses and challenges any reliance upon Official Notice. MPEP 2144.03A (8th ed., rev. 3) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is not appropriate for the Office to take official notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations of the claimed invention as a whole, and not with respect to the limitations individually.

MPEP 2144.03A gives examples of limitations which are considered well known, such as when new audio information is recorded then the old information is erased, or when a heat requirement is varied it is well known to vary a flame. The MPEP states that Official Notice is proper when the *teachings are readily verifiable* (e.g., use of a control in bacteriology). MPEP 2144.03B (8th ed., rev. 3). MPEP 2144.03A and 2144.04E make clear that *Official Notice is proper with respect to facts which are of notorious character and serve only to fill in the gaps in an insubstantial manner*. Appellants respectfully submit that entire positively recited claim limitations absent from the prior art are not notorious and do not fill in gaps in an insubstantial manner but are rather directed toward entire limitations which are not found anywhere in the prior art.

Appellant respectfully submits that the claimed limitations of the list including the plurality of second designations are not of notorious character. The claims recite devices, systems and methods for facilitating consumable replenishment in integrated systems for receiving a first designation and converting the first designation to a second designation. Appellant respectfully submits the

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

use of the claimed list in combination with the other limitations of the respective claims is not notorious, merely gap filling or insubstantial.

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and are not well known. Appellant respectfully requests withdrawal of the rejection over Hayward for at least this reason.

C. Positively recited limitations of claims 3 and 16 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

The claims recite the second message comprising a *quantity corresponding to the imaging consumable identified by the second designation*. The Office at page 3 of the Action states that inherently the purchase order includes quantity referring to Fig. 7 and col. 7, lines 54 to col. 8, lines 63 of Hayward. Appellant respectfully submits the reliance upon inherency is misplaced and the 102 rejection of the claims is improper for at least this additional reason.

In particular, the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly *inherent characteristics necessarily flow from the teachings of the applied prior art*. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). MPEP 2112 IV (8th ed., rev. 3). The limitations of the claims reciting that the second message comprises a quantity do not necessarily flow from the teachings of cols. 7 and 8 of Hayward and the reliance upon inherency is improper. Appellant has failed to locate any teachings that the purchase order described in Hayward (and identified by the Office as allegedly teaching the claimed second message) specifies a quantity of the consumable to be ordered. Numerous alternative arrangements exist apart from the claim limitations. For example, the parties may agree on a default amount of the consumable which is to be sent before the order and then the default is ordered automatically when the purchase order is received. This alternative to the explicit claim language defining that the second message includes a quantity corresponding to the imaging consumable illustrates that alternative arrangements exist from the claims, and accordingly, *the limitations of the claims do not necessarily flow from the teachings of the prior art*. Appellant respectfully submits that the anticipation rejection of the claims is improper for at least this reason.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

D. Positively recited limitations of claims 4, 11, and 17 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

The claims recite the *second message comprising an email message and the second designation is included as an attachment of the email*. On pages 3-5 of the Action, the Office relies upon the teachings of the purchase order of col. 8, lines 5-12 of Hayward as allegedly disclosing the claimed limitations. These teachings of Hayward disclose the application launches an e-mail module to send the purchase order data to the manufacturer's server. The teachings are void of disclosing or suggesting any attachment teachings let alone the second designation identifying the image consumable is an attachment of an email. In addition, Appellant has electronically searched Hayward and failed to locate any reference to "attachment."

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

E. There is insufficient motivation to combine the teachings of Hogge with the teachings of Hayward and the obviousness rejection of claims 5, 12 and 18 is improper for at least this reason.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial*

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

burden of factually supporting any *prima facie* conclusion of obviousness. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §2142 (8th ed., rev. 3).

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority*. The Court also stated that *deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed*. The Court further stated that *the determination of patentability must be based on evidence*. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.

The Office on page 8 of the Action states that Hayward fails to teach or suggest converting manufacturer part numbers to customer part numbers and relies upon the teachings of Hogge to cure the deficiencies of Hayward. Appellant respectfully submits the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

The Office states on page 8 of the Action that the motivation to combine the teachings is to easily correspond manufacturer part number with customer part numbers to ensure the right part is ordered. However, Appellant has failed to locate any teachings in Hayward where manufacturer, customer or different part numbering systems are used. In particular, Hayward at col. 7, lines 63+ states

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

that the purchaser order screen is filled out with a part number to be ordered based on the sensed peripheral condition and Appellant has failed to locate any teachings of deficiencies with respect to such part numbers of the purchase orders and based on the sensed peripheral conditions adequately identifying the parts to be ordered.

In addition, the allegations on page 8 of the Action that the combination allows alternate parts with lower prices and/or availability from different manufacturers by converting/corresponding part numbers between manufactures with reference to Hogge at col. 8, lines 5-10 has not been demonstrated to have any applicability to the teachings of Hayward. Hogge is directed to planning coordination systems for coordinating *separate factory planning systems* as set forth at col. 1, lines 13+. The teachings relied upon by the Office at col. 8 of Hogge merely disclose conversion of part numbers used by other factories to part numbers used by the factory with which the planning system is associated. To the contrary, Hayward discloses an integrated intelligent order system with no teaching of use of different part numbers. There is no evidence of record that the system of Hayward may be modified to accommodate the Hogge teachings in an operable system or that lower prices and/or availability would be achieved as baldly alleged by the Office. Hayward at col. 8, lines 48+ teaches the integrated system wherein the server 40 has pre-arranged contracts with office supply retailers and mail order houses such that server 40 is kept aware of inventory on hand and can confirm availability before sending the shipment order to the retailer. Accordingly, Hayward already teaches arrangements with multiple suppliers/retailers and there is no evidence of record that any benefits over the multiple supplier teachings of Hayward result from the combination proposed by the Office to motivate one to combine the reference teachings of Hogge and Hayward.

In sum, there is no evidence of record that any deficiencies of Hayward are solved by Hogge or other benefits provided to motivate one of skill in the art to combine the references in the arrangement proposed by the Office. Hayward does not teach use of disparate numbering systems and is not directed towards the different factory planning systems of Hogge having different part numbering systems to which the Hogge teachings are applicable. Finally, the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP

PDNO. 10003227-1

Serial No. 09/738,795

Brief of Appellant

52143.01III (8th ed., rev. 3) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The motivation for forming the combination must be something other than hindsight reconstruction based on using Appellant's invention as a road map for such a combination. *See, e.g., In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Appellant respectfully submits without proper objective evidence that the Office has improperly relied upon Appellant's disclosure in formulating the 103 rejection and the Office has failed to establish a proper *prima facie* 103 rejection for at least the above-mentioned reasons.

F. Positively recited limitations of claims 8 and 20 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

Claims 8 and 20 recite processing circuitry configured communicate the second message at a *predetermined moment in time* and communicating the second message at a *predetermined moment in time*, respectively. The Office on pages 3 and 6 relies upon the teachings of col. 8, lines 4-63 of Hayward as allegedly disclosing the limitations of claims 8 and 20. Appellant respectfully submits that the teachings of col. 8 of Hayward fail to disclose the claimed limitations. In particular, the teachings of col. 8 at lines 4+ disclose the browser sends the purchase order *when the user has filled out the purchase order screen*, or the application launches an email module to send the purchase order *when the user has filled out the purchase order screen*. Col. 8, lines 13+ of Hayward disclose a user clicking on a "Buy Now" button and can confirm the purchase order. The timing of the communication of the purchase order in Hayward is chosen by the user and is not disclosed as being at a predetermined moment in time. Appellant has failed to uncover any teaching of the actions of col. 8 of Hayward which result in the communication of the purchase order are at a predetermined moment in time. Appellant has failed to uncover any teachings of *communication of the second message including the second designation at a predetermined moment in time* as claimed.

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

G. Positively recited limitations of claims 21, 23 and 25 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

The claims, in combination with the respective independent claims from which they depend, recite that the second designation is usable by the first entity (for assisting with replenishment of the imaging consumable per the independent claims) to identify the consumable, and the first designation is usable by a second entity to identify the consumable. The Office relies upon the server 40 as allegedly disclosing the second entity and the local supplier as allegedly disclosing the first entity. However, Appellant has failed to identify any teachings in Hayward that a first designation is usable by the second entity to identify the consumable or that a second designation is usable by the first entity to identify the consumable in combination with the teachings of the respective independent claims reciting conversion from the first designation to the second designation. Appellant has failed to uncover any teachings in Hayward of first and second designations to identify the consumable or different entities using plural designations as defined in the claims. The Office has fail to provide any rationale as to why the server 40 and local supplier of Hayward are considered to use plural designations which identify the consumable.

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

H. Positively recited limitations of claims 22, 24 and 26 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.

The claims, in combination with the respective independent claims from which they depend, recite that the first designation is not recognizable by the entity (i.e., the entity to which the second message is communicated to for assisting with replenishment of the consumable per the independent claims), in combination with the claimed converting the first designation identifying the consumable to the second designation identifying the consumable. The Office on pages 6-7 in support of the anticipation rejection of the claims states that parts to be ordered are not

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

recognizable by suppliers until part numbers are submitted with reference to col. 7, lines 54-67 of Hayward. Initially, Appellant notes that Hayward at col. 7, lines 54-67 fails to mention suppliers and fails to teach that parts to be ordered are not recognizable by suppliers until part numbers are submitted as baldly alleged by the Office. To the contrary, the teachings in col. 7 of Hayward at lines 64+ provide that the part number is filled out with the part number to be ordered based on the sensed peripheral condition. Hayward fails to teach that the supplier does not recognize the part number filled in at server 40. Hayward further fails to teach any conversion from the first designation (not recognizable to the entity) to the second designation in combination with forwarding or communicating the second message including the second designation to the entity.

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

I. **Positively recited limitations of claims 27, 29 and 31 are not disclosed nor suggested by the prior art reference Hayward and the anticipation rejection is improper for at least this reason.**

The claims recite, in combination with the respective independent claims, varying forms of *forwarding or communication of the second message* which includes a second designation identifying an imaging consumable *responsive to a predetermined status of the imaging consumable*. The Office on page 7 of the Office Action relies upon the teachings of Fig. 7 and "conditions of image consumable" allegedly taught thereby in support of the 102 rejection. However, referring to Fig. 7, col. 8, lines 5+ of Hayward states that the browser sends the purchase order or the application launches an email module to send the purchase order data when the user has filled out the purchase order screen. Col. 8, lines 20+ of Hayward disclose the user clicking the "Buy Now" button and confirm button to send the purchase order. The teachings relied upon by the Office disclose that the purchase order is sent responsive to user input and the Office has failed to identify teachings of the limitations of forwarding or communicating the second message *responsive to a predetermined status of the imaging consumable* as claimed.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

14

Appellant respectfully submits that the above-recited limitations of the claims are not taught by the prior art and Appellant respectfully requests withdrawal of the 102 rejection over Hayward for at least this reason.

J. Conclusion


In view of the foregoing, reversal of the rejections of the claims is respectfully requested. For any one of the above-stated reasons, the rejections of the respective claims should be reversed. In combination, the above-stated reasons overwhelmingly support such reversal. Accordingly, Appellants respectfully request that the Board reverse the rejections of the claims.

Respectfully submitted,

Date:

9/25/06

Attorney:


James D. Shaurette
Reg. No. 39,833

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

A-1

VIII. CLAIMS APPENDIX

1 1. [Original] A consumable management device comprising:
2 an interface configured to receive a first message including a first
3 designation identifying an imaging consumable used by an image forming device
4 to form hard images; and
5 processing circuitry coupled with the interface, the processing circuitry
6 being configured to convert the first designation identifying the imaging
7 consumable to a second designation identifying the imaging consumable, to
8 generate a second message including the second designation, and to forward
9 the second message to the interface for communication to an entity for assisting
10 with replenishment of the imaging consumable.

1 2. [Original] The device in accordance with claim 1 wherein the
2 interface is configured to receive another first message including another first
3 designation identifying another imaging consumable, and the processing circuitry
4 is configured to convert the another first designation into another second
5 designation identifying the another imaging consumable, and to generate the
6 second message comprising a list including the second designations.

1 3. [Original] The device in accordance with claim 1 wherein the
2 processing circuitry is configured to generate the second message comprising a
3 quantity corresponding to the imaging consumable identified by the second
4 designation.

1 4. [Original] The device in accordance with claim 1 wherein the
2 processing circuitry is configured to generate the second message comprising an
3 email message and to include the second designation as an attachment of the
4 email.

*PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant*

A-2

1 5. [Original] The device in accordance with claim 1 wherein the
2 processing circuitry is configured to covert the first designation comprising a
3 manufacturer part number for the imaging consumable to the second designation
4 comprising a customer part number for the imaging consumable.

1 6. [Original] The device in accordance with claim 1 further
2 comprising storage circuitry configured to store a look-up table, and the
3 processing circuitry is configured to access the look-up table to convert the first
4 designation to the second designation.

1 7. [Original] The device in accordance with claim 1 wherein the
2 processing circuitry is configured to export the second designations into one of a
3 plurality of formats corresponding to the entity to generate the second message.

1 8. [Original] The device in accordance with claim 1 wherein the
2 processing circuitry is configured to communicate the second message at a
3 predetermined moment in time.

1 9. [Original] An image forming system comprising:
2 an image forming device configured to use an imaging consumable to
3 form hard images, to monitor the status of the imaging consumable, and to
4 generate a first message including a first designation identifying the imaging
5 consumable responsive to the monitoring; and
6 a consumable management device coupled with the image forming device
7 and configured to receive the first message, to convert the first designation
8 identifying the imaging consumable to a second designation identifying the
9 imaging consumable, and to communicate a second message including the
10 second designation to an entity for assisting with replenishment of the imaging
11 consumable.

1 10. [Original] The system in accordance with claim 9 wherein the
2 consumable management device is configured to receive another first message
3 including another first designation identifying another imaging consumable, to

PDNO. 10003227-1
Serial No. 09/738,796
Brief of Appellant

A-3

4 convert the another first designation into another second designation identifying
5 the another imaging consumable, and to generate the second message
6 comprising a list including the second designations.

1 11. [Original] The system in accordance with claim 9 wherein the
2 consumable management device is configured to generate the second message
3 comprising an email message and to include the second designation as an
4 attachment of the email.

1 12. [Original] The system in accordance with claim 9 wherein the
2 consumable management device is configured to covert the first designation
3 comprising a manufacturer part number for the imaging consumable to the
4 second designation comprising a customer part number for the imaging
5 consumable.

1 13. [Original] The system in accordance with claim 9 wherein the
2 image forming device comprises a printer.

1 14. [Original] A method of replenishing an imaging consumable usable
2 to form hard images, the method comprising:
3 receiving a first message including a first designation identifying the
4 imaging consumable;
5 converting the first designation to a second designation different than the
6 first designation, the second designation identifying the imaging consumable;
7 generating a second message including the second designation; and
8 communicating the second message including the second designation to
9 an entity for assisting with replenishment of the imaging consumable.

1 15. [Original] The method in accordance with claim 14 wherein the
2 generating comprises generating the second message comprising a list including
3 a plurality of different second designations identifying a plurality of different
4 respective imaging consumables.

*PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant*

A-4

1 16. [Original] The method in accordance with claim 14 wherein the
2 generating comprises generating the second message including a quantity
3 corresponding to the imaging consumable identified by the second designation.

1 17. [Original] The method in accordance with claim 14 wherein the
2 generating comprises:
3 generating the second message comprising an email message; and
4 providing the second designation as an attachment of the email message.

1 18. [Original] The method in accordance with claim 14 wherein the
2 converting comprises converting the first designation comprising a manufacturer
3 part number for the imaging consumable to the second designation comprising a
4 customer part number for the imaging consumable.

1 19. [Original] The method in accordance with claim 14 wherein the
2 generating comprises exporting the second designation into one of a plurality of
3 formats corresponding to the entity.

1 20. [Original] The method in accordance with claim 14 wherein the
2 communicating comprises communicating at a predetermined moment in time.

1 21. [Previously Presented] The device in accordance with claim 1
2 wherein the entity comprises a first entity, and wherein the first designation is
3 usable by a second entity to identify the consumable and the second designation
4 is usable by the first entity different than the second entity to identify the
5 consumable.

1 22. [Previously Presented] The device in accordance with claim 1
2 wherein the first designation is not recognizable by the entity.

1 23. [Previously Presented] The system in accordance with claim 9
2 wherein the entity comprises a first entity, and wherein the first designation is
3 usable by a second entity to identify the consumable and the second designation

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

A-5

4 is usable by the first entity different than the second entity to identify the
5 consumable.

1 24. [Previously Presented] The system in accordance with claim 9
2 wherein the first designation is not recognizable by the entity.

1 25. [Previously Presented] The method in accordance with claim 14
2 wherein the entity comprises a first entity, and wherein the first designation is
3 usable by a second entity to identify the consumable and the second designation
4 is usable by the first entity different than the second entity to identify the
5 consumable.

1 26. [Previously Presented] The method in accordance with claim 14
2 wherein the first designation is not recognizable by the entity.

1 27. [Previously Presented] The device in accordance with claim 1
2 wherein the processing circuitry is configured to forward the second message
3 responsive to a predetermined status of the imaging consumable.

1 28. [Previously Presented] The device in accordance with claim 1
2 wherein the processing circuitry is configured to automatically generate and
3 forward the second message to the interface without user intervention.

1 29. [Previously Presented] The system in accordance with claim 9
2 wherein the consumable management device circuitry is configured to
3 communicate the second message responsive to a predetermined status of the
4 imaging consumable.

1 30. [Previously Presented] The system in accordance with claim 9
2 wherein the consumable management device is configured to automatically
3 communicate the second message without user intervention.

*PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant*

A-6

1 31. [Previously Presented] The method in accordance with claim 14
2 further comprising detecting a predetermined status of the imaging consumable,
3 and wherein the communicating is responsive to the detecting.

1 32. [Previously Presented] The method in accordance with claim 14
2 wherein the generating and the communicating comprise automatically
3 generating and communicating without user intervention.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

B-1

IX. EVIDENCE APPENDIX

Appellants submit no evidence with this appellate brief.

*PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant*

C-1

X. RELATED PROCEEDINGS APPENDIX

Appellants are not aware of any related proceedings.

PDNO. 10003227-1
Serial No. 09/738,795
Brief of Appellant

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